

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-9, 11-14 and 20-28 remain pending in this application. Claims 16-19 and 29-32 have previously been cancelled. Claims 1, 10, 20 and 24 have been amended. Claims 10 and 15 has been cancelled. The amendments made to the claims do not expand the scope of the invention.

Claims 1 and 20 have been objected to under 35 USC §112. Support for the amendments to claims 1 and 20 are found for example in paragraph [0020], [0056] and [0071]. For example, in paragraph [0020] "...several leveling aids enables the business form element combination to lay substantially flat..." In paragraph [0056] it provides that that material may be of the "same thickness or varying in thickness...so that the total thickness through the area of the form is equal for both portions..." See also paragraph [0071] "...a series of leveling aids in order to create a lay flat stack..." See also FIGURE 4 in which the patterns of material are shown to extend from the surface of the substrate such that when a series of forms are placed into a stack such as shown in FIGURE 4B, the forms will create a square stack which will make for easier processing of the forms through for example a laser printer.

The claims 1, 20 and 24 have been amended to illustrate that the leveling aids are added to the surface of the two types of substrates that make up the planar business form to make up for the differential thickness that may be encountered when joining the different substrates together so as to create a lay flat business form assembly. Attention is directed to paragraph [0056] where it is explained that additional patterns of material, of varying thickness are added to the back of the substrates to make the contact points of the form with other forms equal. That is, each contact point, the leading edge of the

form, the point joining the two portions of the form together and the trailing edge of the substrate would each then have a thickness of about 6 mils with each contact point having varying thicknesses of material added at to make the contact points equal. The patterns of material create a leveling effect so as to make the form substantially planar.

Each of claims 1 and 20 have been further amended to indicate that in addition to a pattern of material joining the two portions together, a second pattern of material is provided on each portion and in respect of claim 1, that additional pattern is applied adjacent a side or end edge. None of the foregoing features are taught or suggested by the applied prior art.

The invention described in the application is a relatively straightforward solution to a significant problem. By creating equal points across the surface of the form through the use of leveling aids, the form can lay flat in a stack. It is analogous for example to the legs on a stool, the leveling aids help to maintain the form in a flat arrangement, whereas the prior art forms had only one leg, such as in Welsch (the strip of material holding the two substrates together) or possibly two legs (the strips of material holding the cards in the openings), as in Mercer et al. however, the "legs" are close together and as such would essentially function as a single leg.

"Of course the invention seems simple, after the fact. But simplicity, particularly in an old and crowded art, may argue for rather than against patentability. In re Sporck, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). Progress in the crowded arts, usually made in small increments, is as important as it is in arts at the pioneer stage. In re Hummer, 44 CCPA 814, 241 F.2d 742, 113 USPQ 66 (1957). The Constitution envisages and seeks progress in the "useful arts," not just in those more esoteric or scientific." In re Meng, 181 USPQ 94, 97 (CCPA 1974).

Claims 1-7, 11-14, 20 and 22-23 have been rejected under 35 USC 103(a) as being obvious in view of USP 6,340,512 to Mercer et al. Reconsideration and withdraw of the rejection is earnestly solicited.

Mercer et al. do not teach the present invention. Mercer et al. is a single substrate in which one or more openings have been provided to receive cards. Mercer et al. do not disclose or suggest first and second substrates that are joined to one another along an edge or side and as such do not render the claim obvious, either before or after amendment. It is clear from the specification and the drawings of the instant application that two different components are joined together to create the business form assembly of the present invention.

Mercer et al. is exactly the type of prior art construction over which the present invention is an improvement over. The strips of tape used in Mercer et al. are utilized to hold the cards in place in the openings of the substrate. The two strips are positioned relatively close to one another, disposed at each end of the cards and thus do not provide any leveling effect. (The typical size of an ID card or credit card is roughly 2 ¼" by 3 ½"). If one were to place a series of the business forms described by Mercer et al., the resulting stack would be have a slope or lean as the thickness surrounding the cards and tape would be greater than the thickness at the leading or trailing edge of the business form. That is, the strips of tape along with the thickness of the form create a greater thickness in the area of the tape than in those areas of the substrate where there is no tape creating a slope in the form.

Mercer et al. simply do not teach first and second substrates joined together or the use of leveling aids to create a business form assembly that can be produced in a lay flat configuration. Mercer et al. deal with the proximate problem of containing or holding the cards within the cutouts of the substrate and is not concerned with the differential thicknesses created by that solution in the form assembly. As such, the teachings of Mercer et al. do not provide even the slightest scintilla of knowledge as to how to create a lay flat business form that uses leveling aids to create a lay flat form.

Regarding claim 7, the Examiner's analogy is incorrect, as a series of the sheets described in Mercer et al. would not create a square stack. Consider, for example, a number of sheets. If each sheet had a staple put in the same corner and the sheets were then all stacked together, there would be a slope in the stack in the area created by the difference in thickness created by the staples in the sheet, much like the pile of papers one encounters everyday on the desk. While one sheet with one staple would appear to the naked eye to be generally flat, a group of such sheets would clearly take on a distinctive shaped configuration. Such is the case with the sheets described in Mercer et al. One sheet may appear flat to the naked eye, but a group of such sheets would have a slope, due to the differential thickness of the tape strips. This is exactly the type of problem that the present invention is intended to solve. That is, the present invention applies leveling aids to the form so that the difference in height is mitigated and the form may lay flat in a stack.

Claims 24 and 26-28 have been rejected as being unpatentable over USP 6,340,512 to Mercer et al. in view of Welsh 4,627,994. Reconsideration and withdraw of the rejection is earnestly solicited.

Welsh does not remedy the deficiencies of Mercer et al. Welsh discloses a business form assembly in which two paper plies are held together by an overlapping label ply (adhesive coated paper). Half of the form assembly has twice the thickness of the other half of the assembly. Thus, when placed in a stack, one side of the stack will be taller or higher than the other, again creating the slope, which the present invention solves through the use of leveling aids. Individual form assembly as provided in Welsh simply cannot lay flat, as one portion of the form assembly has twice the thickness of the other portion of the form assembly. If one were to apply the teachings of Welsh to that of

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Mercer et al. the resulting construction would consist of one or more removable cards in openings in one ply that substantially overlies a second ply. Thus, one portion of the form would be twice as thick as the other and a slope would be created.

Claims 8-9 and 21 have been rejected as being unpatentable over USP 6,340,512 to Mercer et al. in view of Downs USP 6,830,795. Reconsideration and withdraw of the rejection is earnestly solicited.

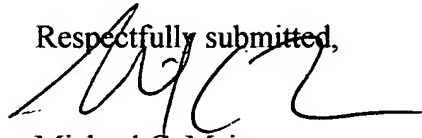
Downs relates to stripe coated linerless labels, which are similar to a roll of tape, in which one surface that is opposed to the adhesive is coated with a release material so that the labels can be removed from the tape roll or tape stack. Downs does nothing to remedy the deficiencies of Mercer et al. If one were to combine the teachings as suggested by the Examiner the resulting business form assembly could not be processed through a non-impact printer as there would be an exposed adhesive surface as each form is removed from the stack or roll and passed to the printer. Each sheet would then likely jam up in the printer as the adhesive would cling to any surface to which the adhesive would come in contact. As such, Downs is simply not combinable with Mercer et al. as in order to make the alleged combination, one would have discard portions of the teaching of Downs, which is impermissible. "It is impermissible to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art" Bausch & Lomb, Inc. v. Barnes-Hind Hydorcurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986).

Claim 25 is rejected been rejected as being unpatentable USP 6,340,512 to Mercer et al. in view of Welsch USP 4,627,994 and further in view of Downs USP 6,830,795. Reconsideration and withdraw of the rejection is earnestly solicited.

For the reasons set forth above, Downs cannot be used in the present combination, as there is an exposed adhesive surface as required by the teachings of Downs, in that each and every time a label is removed from a stack or a roll adhesive is exposed. It is simply not possible to combine the teachings of Downs with the other references as to do so would create a business form assembly that could not be further processed through a printer due to the exposed adhesive surface.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'MCM', is written over the typed name 'Michael C. Maier'.

Michael C. Maier
Reg. No. 36,206

P.O. Box 938
2401 Cooper Street
Fort Scott, KS 66701